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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,548	11/20/2001	Bernd Luhmann	tesa AG 478.2KGB	8904
27384	7590	07/07/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/988,548	LUHMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel Zirker	1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/976,802.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 24-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, upon reconsideration the Examiner now believes that the claim amendments to claim 24 made in the Response filed February 23, 2005 are vague, indefinite and confusing. That is, to substitute the amended clause "... if pulled by itself with the same force necessary to remove said adhesive tape from said substrate" for the previously existing "...if pulled in the absence of said self adhesive composition with the same stripping force necessary to remove said adhesive tape from said substrate" results in a claim which now appears at the very least not readily understandable, which was previously not the case. For example, what does "pulled by itself" mean? Applicants' arguments presented at that time (Response, page 10, top 2 lines) that the change was made to delete the word "stripping" and to make some other editorial changes is, upon reconsideration, not found to be persuasive.

3. Claims 24-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More particularly, upon reconsideration the Examiner now again believes that the rejection set forth in Paragraph No. 6 of Paper

Art Unit: 1771

No.081804 that held the whereby clause present in claim 24 to be new matter is indeed proper for the reasons set forth at that time, which the Examiner believes need little, if any, additional explanation. Nowhere in the specification, including Examples 1 and 2 is there any sort of express support for such a clause, and if the whereby clause is interpreted only to mean that a backing by itself has less tear resistance than a tape formed from the same backing which is also coated with an adhesive layer the Examiner respectfully submits that this simply restates what must be again considered an elementary fact. That fact, as previously stated, is that the type and amount of adhesive utilized in a particular layer(s) structure influences the removable characteristics of the tape, which adhesive coated tape when "pulled by itself" would require a greater amount of force to tear its particular backing than it would to tear the backing, standing alone.

4. Claims 24-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO '691, substantially for reasons set forth in Paragraph No. 2 of Paper No. 041905, together with the following additional observations. More particularly, the Examiner has little to add except to note that the only way the whereby clause present in claim 24 makes sense is if it is to be interpreted as set forth in the preceeding paragraph, where it may state the elementary principle that the article comprising a backing coated with an adhesive layer requires a greater tear strength to tear its backing when pulled than just the backing, standing by itself, when pulled. Since the reference, as previously set forth during the prosecution history, discloses a significant number of embodiments that read upon those embodiments

Art Unit: 1771

which the reference teaches are operable one of ordinary skill would simply look to these disclosed embodiments present in the reference and at most subject each of them to the test set forth in the whereby clause which would point determine those embodiments which either inherently anticipated the claimed invention, or what minor modifications needed to be made to render the claimed tape (and accompanying method of use of claims 34 and 35) obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/988,548

Page 5

Art Unit: 1771

Daniel Zirker  
Primary Examiner  
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style, with the first name "Daniel" and the last name "Zirker" clearly distinguishable.